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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/887,693 | 09/18/2001 | JOSEPH L. WAISMAN | CIP-2 | 7614 |

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EXAMINER

BEHREND, HARVEY E

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887693

Applicant(s)

Waisman et al

Examiner

Behrend

Group Art Unit

3641

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-27 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-19, drawn to a system, classified in class 376, subclass 100.
 - II. Claims 20, 21, 26, 27, drawn to a method, classified in class 376, subclass 100.
 - III. Claim 22, drawn to a system, classified in class 376, subclass 245.
 - IV. Claims 23-25, drawn to a method, classified in class 376, subclass 256.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as a process wherein the gas pressure is below 25 atmospheres or even above 2000 atmospheres and/or by utilizing deuterium chemical potentials that are below or equal to the measured threshold deuterium chemical potentials for the host metal.

Inventions III and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed could be used to practice another and materially method such as a method utilizing deuterium gas pressures below 5

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atmospheres or above 4000 atmospheres and/or a method wherein the gas chemical potential is only determined when a large amount of heat is generated (in contrast to the onset of heat generation) and/or wherein only a single heat generation rate is measured.

Groups (I, II) and Groups (III, IV) are independent and distinct on their face, from each other. Groups (I, II) being directed to a system and method for generating solid state deuterium fusion heat, whereas, Group (III, IV) in contrast are directed to a system and method for testing metals.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for Group II is not required for Group I and because the search required for Group IV is not required for Group III, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Upon election of one of the inventions identified above as I, II, III, and IV applicant is further required under 35 U.S.C 121 to elect a single species of host metal, for purposes of examination. This is to facilitate examining due to the broad range of materials disclosed and claimed as being suitable (e.g. see clams 5-16).

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3. Upon election of one of the inventions identified above as I, II, III, and IV applicant is also required to elect under 35 U.S.C 121 one of the following forms of host metal.

- A. Wherein the host metal is made in the form of a tube by a bulk technique (as set forth in the specification on page 12 lines 15-23)
- B. Wherein the host metal is in powdered form which is then sintered (as set forth in the specification on page 12 lines 24-30).
- C. Wherein the host metal is formed by a vapor deposition technique (as set forth in the specification on page 12 lines 31-33).

4. If invention I or invention II is elected, applicant is further required under 35 USC 121 to elect one of the following disclosed species for prosecution on the merits to which the claims shall be restricted.

- X. The embodiment as set forth in Fig. 1.
- Y. The embodiment as set forth in Fig. 2.
- Z. The embodiment as set forth in Fig. 4.

5. Applicant is advised that a reply to the election of species requirements must include an identification of the species that is elected consonant with the requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

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all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species, MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Behrend/kn
April 8, 2003



HARVEY E. BEHREND
PRIMARY EXAMINER